

REMARKS

Claims 1- 21 were presented when the instant application was filed. Subsequently, in a response to a restriction requirement, Applicants elected to prosecute Claims 1-15 of Group I, and canceled Claims 16-21 without prejudice to their future prosecution. Thus Claims 1-15 are currently pending. In the Advisory Action mailed January 28, 2005, the Examiner has withdrawn the rejection of Claims 7 and 15 under 35 USC § 112, second paragraph, but has maintained the rejection of:

- 1) Claims 1-15 under 35 USC § 102(e) as allegedly being anticipated by Straus (US Publication No. 2002/0086289 A1) as evidenced by DeRisi *et al.* (Science 278:680-686, 1997).

Applicants hereby amend Claims 1 and 9, in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments. Applicants reserve the right to prosecute the original, similar, or broader claims in one or more future application(s). These amendments do not introduce new matter and are not intended to narrow the scope of any of the claims within the meaning of *Festo*.¹

1) The Claims Are Novel

The Examiner has rejected Claims 1-15 under 35 U.S.C. § 102(e), as allegedly being anticipated by Straus (US Publication No. 2002/0086289 A1) as evidenced by DeRisi *et al.* (Science 278:680-686, 1997). The Examiner reiterated the anticipation rejection from the prior Office Action:

Straus discloses a method for identifying bacteria in which labeled target DNA from a test sample including bacteria is hybridized to a "detection ensemble". . . Straus further discloses both the combination of positive and negative control probes with test sample molecules prior to hybridization (see, e.g., page 19), and preparation of a database of fingerprints with which test sample patterns may be compared (see, e.g., page 28). . . It is again noted that Straus (at, e.g., page 19) clearly teaches the simultaneous hybridization of test and positive control molecules. While it is acknowledged that the method of Straus employs multiple hybridization steps, the instant claims recite the open transitional language "comprising," and therefore clearly encompass methods including any type of additional steps, including additional hybridization steps. Further, Applicants'

¹ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002).

specification does not include, e.g., a limiting type of definition for the term “co-hybridizing” or “co-hybridization” that would exclude the hybridization practiced by Straus (Final Office Action, pages 3-5).

In addition, the Examiner states:

[w]hile Applicant argues that Straus “does not teach hybridizing labeled target DNA,” making reference to Figure 5 and paragraphs 146-149 of Straus, Straus does in fact disclose the incorporation of labels during amplification prior to hybridization with the “detection ensemble” (see pages 10-20). Thus, this argument is not persuasive (Advisory Action, page 2).

Applicants respectfully disagree that the pending claims are anticipated by Straus, and remind the Examiner that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”² Applicants reiterate that Straus does not teach providing both **labeled target DNA** and **labeled reference DNA**. As clearly shown in Figure 5 and as described in Step 6 of the Straus’ genomic profiling method, Straus discloses “amplifying the ID probes that bind to the genomic sequences in the sample” and “[t]he amplified products can be labeled during amplification” (Straus, paragraphs 0226-0228).

Nonetheless, Applicants have amended Claim 1 and 7 in order to further the prosecution of the present application and Applicants' business interests, yet without acquiescing to the Examiner's arguments, and while reserving the right to prosecute the original, similar, or broader claims in one or more future application(s). Specifically, Applicants have amended Claims 1 and 7 to recite “co-hybridizing said target and reference DNA to said arrayed elements **in a single step.**” Support for this amendment is found for instance in Example 2, which teaches the labeling of genomic DNA with Cy3 for use as test DNA, and the labeling of reference DNA with Cy5. The arrays were then “hybridized with approximately 1 mg of Cy3- and Cy5-labeled DNA mixture (1:1) in hybridization buffer” (Specification, at page 33, lines 17-22). As Straus does not teach or suggest at least two elements of the claimed invention, Straus clearly does not anticipate the claims.

² *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

CONCLUSION

Applicants believe the amendments and arguments set forth above traverse the Examiner's rejections and, therefore, request that a timely Notice of Allowance be issued in this case. However, should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

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